

### **REMARKS**

The Office Action of December 23, 2009 has been reviewed and the Examiner's comments carefully considered. Claim 17 has been amended in accordance with the originally-filed specification. No new matter has been added. Claims 17-32 are pending in this application, and claim 17 is in independent form.

The Examiner is thanked for considering the previously-filed Amendment of September 16, 2009, the content of which is incorporated herein by reference. In particular, in that previously-filed Amendment, independent claim 17 was modified to more clearly describe the environment and appropriate usage of the presently-invented device. In particular, the "snug fit surface" is more clearly defined as a surface that includes "at least one rigid portion which can cause irritation to the skin."

In response to this Amendment, the Examiner has again rejected claims 17-32. In particular, these claims stand rejected under 35 U.S.C. § 103(a) as being obvious over the previously-cited Pierce, Jr. patent (U.S. Patent No. 4,756,026). Further, claims 17-32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner believes that the recitation "including at least one rigid portion which can cause irritation to the skin" is indefinite since it is unclear to the Examiner why the presently-invented device would want to create irritation and discomfort to the user. The Examiner also indicates that the specification of the present application mentions that the device prevents irritation as opposed to creating it. In view of the following remarks, Applicant respectfully requests reconsideration of these rejections.

### **Summary of the Preferred Embodiment**

As set forth in independent claim 17 of the present application, provided is a device for protecting an irritable surface of the skin of a leg against irritation from contact with an irritable snug fit surface fitted around the leg adjacent to the skin. Such an irritable snug fit surface may constitute a surface of footwear extending towards the skin of the leg, and further, this snug fit surface includes at least one rigid portion that can cause irritation to the skin.

The claimed device includes a body with an underside, an upper side, and a protective part, and the body is adapted for placing around at least a forward part of a leg above the foot in a vertical direction. It is this forward part of the leg that constitutes the irritable surface of the skin to be protected from irritation. The body of the device comprises a material with elastic properties, and at least partially encloses the leg in the horizontal direction. In addition, the protective part of the body, which in use is adjacent to the skin to be protected, extends between the skin and the irritable snug fit surface and is in the form of an elastic material. Further, the protected part of the body is capable of fitting between the leg and the above-discussed snug fit surface.

#### The Pierce, Jr. Patent

The Pierce, Jr. patent has been fully discussed in the previously-filed Amendment. In summary, the Pierce, Jr. patent is directed to a protective device that can be worn around the leg, and with reference to Fig. 5 of this document, the shin guard (10) of the Pierce, Jr. patent includes a shin guard protection sleeve (50), which is constructed of a resilient foam panel (50) and side edge pads (54). These panels are enveloped in and stitchably attached to the elastic sleeve (56). The Examiner further refers to protection panel (62), edge pads (64), edge pad (66).

Accordingly, the Pierce, Jr. patent teaches a well-known shin pad or shin guard that fits over the shin of a user for use in a variety of activities, typically high contact activities, such as contact sports or the like. In operation, the shin guard (10) is slid over the user's leg and used during the contact activity either directly exposed or underneath a sock, pantleg, or the like. For further protection, the protection panel (16) may provide for the insertion or use of enveloping strips (18), which may be in the form of a rigid thermoplastic polymer impact strip. Accordingly, the Pierce, Jr. patent is directed to a limb protector for protection against damaging blows that occur during the play of contact sports and similar activities.

#### Claims 17-32 Are Definite

As stated above, the Examiner is unclear regarding certain features of the claims,

as, in the Examiner's opinion, the presently-invented device seeks to create irritation and discomfort, as opposed to preventing it. Such an interpretation stems from a misunderstanding of the preamble to independent claim 17. In particular, independent claim 17 is directed to "A device for protecting an irritable surface of the skin of a leg against irritation from contact with an irritable snug fit surface fitted around the leg adjacent to the skin...said device comprising..." This clearly establishes that the presently-invented device is to protect against irritation of skin of the user's leg that is caused by another, existing device or surface. Accordingly, the "irritable snug fit surface" referred to in claim 17 defines this existing irritation-producing surface or device, such as a surface of footwear extending toward the skin of the leg. The primary example discussed throughout the present application is a ski boot, as illustrated in Fig. 1. As is known, the skier places the boot on his or her foot and leans his or her shin towards the inner surface of the boot. It is this inner surface of the boot that comprises the irritable snug fit surface for which the presently-invented device is utilized.

In order to further clarify the arrangement and positioning between the presently-invented device and this external device or fitting, e.g., a ski boot, Applicant included the further description of this device in the preamble to independent claim 17 in the previously-filed Amendment. In particular, the following description was added: "the snug fit surface including at least one rigid portion which can cause irritation to the skin." As is known, a ski boot, which must necessarily snugly fit around the user's foot and lower leg includes multiple rigid portions that lead to severe irritation to the skin of the skier (or user). Accordingly, this description in no way describes the claimed device, itself, and instead further describes the external device that includes the snug fit surface that causes the irritation. In short, the device of the present invention protects irritation from prolonged exposure, such as rubbing or pressing, while the user's skin is exposed to the continually-moving perpendicular motion of the boot (the inside of which includes the irritable snug fit surface with rigid portions).

Accordingly, Applicant believes that no further amendments are required to the claim given the above explanation of the previous modifications made in the last Amendment. On this basis, withdrawal of the Section 112, second paragraph, rejection of claims 17-32 is respectfully requested.

The Device of Claim 17 is Not Taught or Suggested in the Cited Reference

As discussed above, the present invention provides a device for protecting an irritable surface of the skin of a leg against irritation from contact with an irritable snug fit surface fitted around the leg adjacent to the skin. This snug fit surface includes at least one rigid portion, which, in one preferred and non-limiting embodiment, constitutes the inner surface of a ski boot. Therefore, the present invention is directed to a device that fits and is used between the user's skin and the inner surface of the ski boot (or other similar snug fit member).

In order to protect against irritation due to rubbing and contact between the irritable snug fit surface and the skin of the user's leg, the body of the presently-invented device includes elastic properties, where the protective part of this body comprises only an elastic material (to prevent irritation), but which is also formed in order to fit between the leg and the above-mentioned snug fit surface.

The limb protector of the Pierce, Jr. patent is clearly a shin guard that is not and could not be effectively positioned between a snug fit member or device and a user's skin to prevent irritation to the skin surface. Instead, the Pierce, Jr. arrangement is simply padding (optionally using rigid inserts) to protect against injury when the user is engaging in physical contact activities.

In reviewing the described and illustrated embodiments of the Pierce, Jr. patent, it is clear that none of these embodiments and arrangements could effectively fit between a leg and a snug fit surface, such as a ski boot. Again, the present invention indicates that the protective part of the body comprises only elastic material and is capable of fitting between a leg and the snug fit surface. Such an arrangement could not be implemented using the limb protector of the Pierce, Jr. patent.

For example, the limb protector of the Pierce, Jr. patent could not be positioned in a ski boot, since, based upon the padding and other inserts, this limb protector clearly could not be used in connection with a snug fit device or member, such as a ski boot, where the skier is constantly leaning forward and pressing against the front side of the boot with his or her shin bone. This is further borne out by the fact that the nature of a snug fit surface is that there is

virtually no room for extensive and thick padding arrangements, such as those arrangements and embodiments of the Pierce, Jr. patent. In fact, the limb protector of the Pierce, Jr. patent would actually cause extra irritation, since if one were to use the embodiment of Fig. 1, the rigid portions (18) would be placed within the boot.

In summary, the irritation that is discussed in independent claim 17 of the present application is caused by one or more rigid portions that are external to the device of the present invention, i.e., rigid portions associated with the snug fit member (or inner surface of this member). Such rigid portions of this external member are pressed towards and against the skin as it is laced up or fitted with the specific intention of having a snug or close fit. Therefore, using the thick, padded arrangement of the Pierce, Jr. patent actually teaches away from the present invention, as it could not fit between the user's skin and the inner surface of the snug fit device, and if forced to do so, would cause excessive amounts of irritation.

Therefore, Applicant respectfully submits that the Pierce, Jr. patent does not teach or suggest a device for protecting an irritable surface of the skin of a leg against irritation from contact with an irritable snug fit surface, where this device includes, inter alia, a body with a protective part that comprises only elastic material and is capable of fitting between a leg and the snug fit surface, such as an inner surface of a ski boot.

### Summary


For at least the foregoing reasons, independent claim 17 is not anticipated by or rendered obvious over the Pierce, Jr. patent or any of the art of record, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claim 17 is respectfully requested. Claims 18-32 depend either directly or indirectly from and add further limitations to independent claim 17 and are believed to be allowable for at least the reasons discussed hereinabove in connection with independent claim 17. Therefore, for the above reasons, reconsideration of the rejections of claims 18-32 is respectfully requested.

For the foregoing reasons, Applicant believes that claims 17-32 are patentable

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over the cited prior art and in condition for allowance. Reconsideration of the rejections and allowance of all pending claims 17-32 are respectfully requested. Further, the Examiner is invited to contact the undersigned with any additional questions regarding the operation or positioning of the presently-invented device and its environment. Still further, Applicant remains willing to work with the Examiner to identify patentable subject matter and move this case expeditiously towards allowance.

Respectfully submitted,  
THE WEBB LAW FIRM

By   
Nathan J. Prepelka  
Registration No. 43,016  
Attorney for Applicant  
436 Seventh Avenue  
700 Koppers Building  
Pittsburgh, PA 15219  
Telephone: (412) 471-8815  
Facsimile: (412) 471-4094  
E-mail: webblaw@webblaw.com